UNITED STATES PATENT AND TRADEMARK OFFICE

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 09/714,280 | 11/17/2000 | Bruce W. Robinson | 38898-0004 | 5535 |

| 7590 | 07/21/2004 |
|---|---|

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| EXAMINER |
|---|
| HO, DUC CHI |

| ART UNIT | PAPER NUMBER |
|---|---|
| 2665 | 2 |

DATE MAILED: 07/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on *17 November 2000*.

2a)☐ This action is **FINAL.**    2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *1-22* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☒ Claim(s) *1-4 and 8-11* is/are allowed.

6)☐ Claim(s) _____ is/are rejected.

7)☒ Claim(s) *5-10 and 12-22* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some *   c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage

        application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

## DETAILED ACTION

### *Claim Objections*

1.      Claims 5-7, 11 and 12-22 are objected to because of the following informalities:

Regarding claim 5, line 2, recites the limitation "said step". There is insufficient antecedent basis for this limitation in the claim.

Regarding claim 11, line 2, recites the limitation "said appearance". There is insufficient antecedent basis for this limitation in the claim.

Regarding claim 12, lines 4-5, recites the limitation "said dissimilar communication network", "said other communication network". There are insufficient antecedent basis for these limitations in the claim.  The same remark applies to claims 16-17.

Regarding claim 13, line 3, recites the limitation "said communication network". There is insufficient antecedent basis for this limitation in the claim.

Regarding claim 19, lines 5-8, recites the limitation "said other communication network", "said communication networks". There are insufficient antecedent basis for these limitations in the claim.

Regarding claim 20, lines 3-4, recites the limitation "said communication network". There is insufficient antecedent basis for this limitation in the claim.

Appropriate correction is required.

### *Allowable Subject Matter*

2.      Claims 1-4, and 8-10 are allowed.

3.      Claims 5-7, 11, and12-22 would be allowable if rewritten to overcome the objections as set forth above.


### Conclusion

4.      The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.  Kung et al. (US 6,728,239); Sakamoto (US 6,272,194); Okamoto et al. (US 5,228,036) are cited to show a method and apparatus for data-path conversion comprising PCM bit robbing signaling, which is considered pertinent to the claimed invention.

5.      Any inquiry concerning this communication or earlier communications from the examiner should be directed to Duc Ho whose telephone number is (703) 305-1332. The examiner can normally be reached on Monday through Friday from 7:00 am to 3:30 pm.

If attempt to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Huy Vu, can be reached on (703) 308-6602.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-4750

6.      Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington, D.C. 20231

**or faxed to:**

(703) 872-9314

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal

Drive,

Arlington. VA, Sixth Floor (Receptionist).


Patent Examiner

Duc Ho

7-9-04